REMARKS

In the Office Action that was mailed on 01/09/2007, claims 1-29 and 31-46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Chandra (US6085342A), Adachi (JP07108119), Hussey (US5826269A), Kaji (US4775956A1), Blakeley et al. (US5563878 A), Kay (US6121533A), Larson et al.(U.S. Pub. 2004/0098485A1), Eric Bach "Efficient Prediction of Marsaglia-Zaman Random Number Generators", McFiggins (US3792446A), Gu (US5874988A), Gabbler (5961593A), Evans (US6430708 B1), Ganesan (US 5588056A), and Jim DeRoest "Hardening AIX Security',SunExnert, Brookline: MA, Sept. 1998, Vol. 9, Iss. 9, pg. 60, 4 pgs. The foregoing rejections are respectfully traversed. Applicants note with appreciation that Claim 30 is allowed.

Claims 1-46 are pending in the subject application, of which claims 1, 16, 17, 23, 24, 30, and 31 are independent claims.

Declaration under 37 CFR 1.131

As a preliminary matter, applicants note that the Declaration pursuant to 37CFR 1.131 was not expressly acknowledged or accepted in the previous office action. Applicants respectfully request express acceptance of the Declaration.

Rejections based on 35 U.S.C. § 103(a)

A. Applicable Authority

The basic requirements of a *prima facie* case of obviousness are summarized in MPEP § 2143 through § 2143.04. In order "[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success [in combining the references]. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)". *See* MPEP § 2143.

Further, in establishing a *prima facie* case of obviousness, the initial burden is placed on the Examiner. "To support the conclusion that the claimed invention is directed to obvious

subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 USPQ 972, 972, (Bd. Pat App. & Inter. 1985)." *Id. See also* MPEP § 706.02(j) and § 2142.

B. References Fail to Teach or Suggest All Claim Limitations

Applicants respectfully submit that a *prima facie* case of obviousness has not been established because the combination of references cited in the Office Action fails to teach or suggest all the claim limitations for each of claims 1-29, and 31-46. Referring initially to independent Claim 1,

> A method of producing a unique modified account name based on a requested account name that has been determined to already exist, the method comprising: in a computing environment, receiving a requested account name from a user, in a computing environment, selecting a preexisting word element from at least one preexisting list of word elements, in a computing environment, combining the preexisting word element and at least a stem of the requested account name to produce a modified account name, in a computing environment, comparing the modified account name with a list of existing account names to determine whether the modified account name is unique, and in a computing environment, if the modified account name is unique, providing the modified account name to the user for acceptance.

Claim 1 was rejected, based on a combination of Chandra, Blakeley et al., Adachi, Hussey, and Kaji et al., however, taken together, these references fail to teach or suggest all the claim limitations found in Claim 1.

Chandra discusses a method of assigning a user ID where the individual user proposes an ID or, alternatively, the program randomly generates an ID that is not based on the user proposed ID. The randomly generated ID is not checked for uniqueness prior to presentation to the user for acceptance. (Fig. 4) Once the user proposes an ID or accepts the randomly generated ID, the method conducts an uniqueness search. (Fig. 4) If the user proposed or randomly generated ID is not unique the program proposes another randomly generated ID prior to checking it for uniqueness, or gives the user another opportunity to submit a user ID of the user's choosing. The process repeats until the user enters or accepts a unique ID. (Chandra Abstract, col. 5, lines 17-60) Chandra does not teach the following elements of Claim 1:

> selecting a preexisting word element from at least one preexisting list of word

> elements, . . .combining the preexisting word element and at least a stem of the requested account name to produce a modified account name . . .comparing the modified account name with a list of existing account names to determine whether the modified account name is unique . . . if the modified account name is unique, providing the modified account name to the user for acceptance.

Chandra does not prevent users from becoming frustrated by repeated uniqueness rejections, since it does not offer users pre-qualified ID's that have been checked for uniqueness Additionally, the names proposed by the method have no relation to the original user ID requested by the user. At best, Chandra only teaches requesting a user ID from the user, and none of the other Claim 1 limitations.

The Blakeley et al. reference is cited in the Office Action for a background discussion of networking naming protocol, and discusses allowing network administrators to name network nodes in the same group by appending additional characters to the master group name. (col 5. lines 30-67) The cited discussion does not teach or suggest a method that is executed automatically in a computing environment and, therefore, does not teach or suggest any of the Claim 1 limitations.

Adachi discusses a method of naming sound files by allowing the operator to select a word, words, or word abbreviations from a preexisting list of words typically used to describe such files. The program then uses these operator selected words to name the file. The purpose of this program is to avoid misspellings that can hinder future file name searches. Adachi does not teach a method where the program receives a suggested file name from the user. The program does not automatically select a word from a preexisting list, rather, it supplies the list to the user to select the word or words that describe the file. Additionally, Adachi does not test for uniqueness, and it does not suggest a modified name for acceptance by the user. Therefore, Adachi does not teach or suggest any of the Claim 1 limitations.

Hussey is cited in the Office Action as disclosing a method of requesting or receiving an new account name from a user. Hussey does not teach or suggest a method of producing a unique modified account name (i.e., a new account name) for a user as recited in Claim 1. Instead, Hussey teaches that the user is asked to submit an old, existing account name, such as a recipients email address.(col. 8, lines 30-45) Hussey is not related to creating a new account name and does not teach or suggest any of the Claim 1 limitations.

Kaji discusses a method of using word stems as a data compression technique that will reduce the need for data storage. The program stores words as word stems and then converts

them back to the full original word when output of the data is required.(Abstract, col. 2, Lines 1-15) Kaji uses the same phrase, "word stem," recited in Claim 1, but the use and purpose of the phrase is not analogous to the use in Claim 1. Claim 1, uses "word stem" to indicate that the invention will use the user proposed account name as the basis for the modified account name. "Word stem" also is used to indicate the invention may modify either part of the original user requested account name or the full user requested account name. Therefore, Kaji does not teach or suggest any of the Claim 1 limitations.

At best, a combination of Chandra, Blakeley et al, Adachi, Hussey, and Kaji et al., only discloses requesting an account name from the user, but does not teach any of the remaining limitations in Claim 1. The references fail to teach or suggest at least four of the Claim 1 limitations, and therefore, a *prima facie* case for obviousness under 35 U.S.C. § 103(a) has not been established. Further, because the additional references cited to Claims 2-15,32,35,38,41,42, and 45, which are dependant on Claim 1, fail to cure this defect, the *prima facie* case against claims 2-15,32,35,38,41,42, and 45 also fails.

Referring next to independent claim 16, which states:

> A computer-readable medium having computer-executable instructions for a method of producing a unique modified account name based on a requested account name that has been determined to already exist, the method comprising: selecting a preexisting word element from at least one preexisting list of word elements, combining the preexisting word element and at least a stem of the requested account name to produce a modified account name, comparing the modified account name with a list of existing account names to determine whether the modified account name is unique, and if the modified account name is unique, providing the modified account name to the user for acceptance.

Claim 16 was rejected, based on a combination of Chandra, Blakeley et al, Adachi, Hussey, and Kaji et al., however, taken together, these references fail to teach or suggest all the claim limitations found in Claim 16. For all of the reasons discussed previously regarding Claim 1, a combination of Chandra, Blakeley et al, Adachi, Hussey, and Kaji et al., only discloses requesting an account name from the user, but do not teach any of the remaining limitations in Claim 16. The references fail to teach or suggest at least four of the Claim 16 limitations, and, therefore, a *prima facie* case for obviousness under 35 U.S.C. § 103(a) has not been established.

Referring next to independent claim 17, which states:

> A method of producing a unique random account name in response to a request by a user, the method comprising: in a computing environment, receiving a requested account name from a user, in a computing environment, selecting a first preexisting word element from a database including at least one preexisting list of word elements, in a computing environment, selecting a second preexisting word element from the database, in a computing environment, combining the first and second preexisting word elements to produce a random account name, in a computing environment, comparing the random account name with a list of existing account names to determine if the random account name is unique; and in a computing environment, if the random account name is unique, providing the random account name to the user for acceptance.

Claim 17 was rejected, based on a combination of Gabbler et al., Blakeley et al, and Hussey, however, taken together, these references fail to teach or suggest all the claim limitations found in Claim 17

Gabbler et al. discusses a method for a proxy server to randomly generate user ID's and passwords that the proxy server will give to websites that require user registration. The proxy server will use these passwords to function as a passport into all sites requiring registration, while protecting the privacy of the individual using the proxy server. Grabbler et al. does not generate the random user ID's in the same manner as in Claim 17. Specifically, Grabbler et al. does not generate passwords by accessing a list of word elements once, or twice. Grabbler et al., also does not combine two elements from an existing list to form the unique random ID. Finally, Grabbler et al. does not present these ID's and passwords to the user for acceptance. The entire ID and password generation is "transparent to the user." (Grabbler et al. col 8, line 60). Therefore, these four limitations to Claim 17 are not taught or suggested by Grabbler et al.

The Office Action quotes an article entitled "Web e-mail services" written by Scott Nesbitt. The Office Action incorrectly attributes this information to Blakeley et al. The Nesbitt article is not prior art because it was sworn behind in a response dated 11/01/2006. Additionally, the section of article quoted in the Office Action does not teach or suggest adding words or numbers to the user proposed ID. Instead the Nesbitt article describes a program that uses derivatives of the proposed user ID. Further, the Nesbitt article does not describe using a list of existing words to randomly generate a unique ID by adding it to the user proposed ID.

The combined references fail to teach or suggest at least three of the Claim 17 limitations, including building the random account name from an existing list of words. Therefore, a *prima facie* case for obviousness under 35 U.S.C. § 103(a) has not been established. Further, because the additional references cited to Claims 18-20,33,36,39, and 46,

which are dependant on Claim 17, fail to cure this defect, the *prima facie* case against claims 18-22,33,36,39, and 46 also fails.

Referring next to independent claim 23, which states:

> A computer-readable medium having computer-executable instructions for performing a method of producing a unique random account name in response to a request by a user, the method comprising: selecting a first preexisting word element from a database including at least one preexisting list of word elements, selecting a second preexisting word element from the database, combining the first and second preexisting word elements to produce a random account name, comparing the account name with a list of existing account names to determine if the account name is unique; and if the account name is unique, providing the account name to the user for acceptance.

Claim 23 was rejected, based on a combination Gabbler et al., and Blakeley et al.(Nesbitt article), however, taken together, these references fail to teach or suggest all the claim limitations found in Claim 23. As explained above, under the discussion of Claim 17, a combination of Gabbler et al., and Blakeley et al., fail to teach or suggest several Claim 23 limitations, including building a unique random account name from an existing list of words. Therefore, a *prima facie* case for obviousness under 35 U.S.C. § 103(a) has not been established for Claim 23.

Referring next to independent claim 24, which states:

> A computer-readable medium having computer-executable components for producing a unique modified account name based on a requested account name that has been determined to already exist, comprising: a user interface component for receiving an account name request, a database component including at least one preexisting list of word elements and a list of existing account names, a name generating component for selecting preexisting word elements from the at least one preexisting list of word elements and combining the preexisting word elements with at least a stem of the requested account name to produce modified account names, if the requested account name is not unique when compared to the list of existing account names; and a search component for comparing the modified account names with a list of existing account names to determine whether the modified account names are unique and, if the modified account names are unique, providing the modified account names to the user for acceptance.

Claim 24 was rejected, based on a combination of Chandra, Blakeley et al.(Nesbitt), Adachi, Hussey, and Kaji et al., however, taken together, these references fail to teach or suggest all the claim limitations found in Claim 24. A combination of Chandra, Blakeley et al., Adachi, Hussey, and Kaji et al. fails to teach or suggest at least four of the Claim 24 limitations, and therefore, a *prima facie* case for obviousness under 35 U.S.C. § 103(a) has not been

established. Further, because the additional references cited to Claims 25-29,34,37,40,43, and 44, which are dependant on Claim 24, fail to cure this defect, the *prima facie* case against claims 25-29,34,37,40,43, and 44 also fails.

Referring finally to independent claim 31, which states:

> A method of producing a unique random account name in response to a request by a user, the method comprising: in a computing environment, receiving a request to generate a unique random account name from a user, in a computing environment, providing without any input or suggestion of names from the user, a list of multiple alternate unique account names, and in a computing environment, providing the user with the ability to select any one of said alternate unique account names, enter a new string for use as an account name or request an automated generation of a new list of multiple alternate unique account names.

Claim 31 was rejected, based on a combination of Kay, Blakeley et al.(Nesbitt), Evans, and Ganesan, however, taken together, these references fail to teach or suggest all the claim limitations found in Claim 31.

Kay discusses the use of a random number generator in a computing environment, as well as a method for generating or storing random music. (col. 3, lines 5-50 and col 4, Lines 10-25, col. 22, lines 5-67) Kay does not check its output for uniqueness, and does not allow users to select specific outputs. Additionally, Kay has nothing to do with account names.

Evans discusses a method to populate a file that can be used to test newly acquired computer programs on a test computer prior to implementing the new program in a real business setting. This output is not random and must meet very specific requirements to effectively test the new programs. This output is generated based on user input, and may be modified by the user if the method does not output usable test data. (Evans Col 8, Lines 10-35). The Office Action appears to take the very specific disclosures of Evans, that are not analogous to limitations in Claim 31, and broaden them to a disclosure of a program that takes input and generates output that can then be modified by the user. This would be true of numerous computer programs and does not relate to a limitation in Claim 31. Therefore, Evans does not teach or suggest any of the limitations found in Claim 31.

Ganesan discusses a method to generate a password by combining word segments in such a way that the resulting password is not a dictionary word, but is, nevertheless, pronounceable. The purpose of this method is to produce passwords that are difficult to break, but still relatively easy to remember. (Ganesan col 21 line 60-col. 22, line 25.). Additionally, the passwords are the result of an algorithm that will exclude unpronounceable words and only uses

actual word segments as building blocks. The passwords are not presented to the user for acceptance and are not checked for uniqueness.

A combination of Kay, Blakeley et al.(Nesbitt), Evans, and Ganesan., does not teach all of the limitations in Claim 31. In particular, the references fail to teach or suggest several of the Claim 31 limitations, including testing the account name for uniqueness, or giving the user the opportunity to propose an account name. Therefore, a *prima facie* case for obviousness under 35 U.S.C. § 103(a) has not been established for Claim 31.

C. Lack of Suggestion or Motivation to Combine the Cited References

Applicants also respectfully submit that a *prima facie* case of obviousness has not been established for each of claims 1-29 and 31-46 because the Office Action does not set forth any suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the various references cited against the above referenced claims.

"The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. 'To support the conclusions that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.' *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat App. & Inter. 1985)." MPEP § 2142. MPEP § 2142 further states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper." The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" *Dembiczak*, 50 USPQ2d at 1617. "'The factual inquiry whether to combine the references must be thorough and searching.'" *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing *McGinley v. Franklin Sports, Inc.*, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. *Id.* at 1433-34. The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.

In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

The Examiner has not presented any evidence why the various references would have been combined. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01. Specifically, there must be a suggestion or motivation in the references to make the combination or modification. *Id.* Such motivation does not appear anywhere in any of the references, and the Examiner has not presented any actual evidence in support of the same. Instead, the Examiner relies on broad conclusory statements, subjective belief, and unknown authority. Such a basis does not adequately support the combination of references; therefore, the combination is improper and should be withdrawn.

Conclusion

Withdrawal of the foregoing rejections is respectfully requested. The remarks herein are to be interpreted only in the context of the specific claims for which they are presented.

There being no further objections or rejections, it is submitted that the application is in condition for allowance, which action is courteously requested. Finally, if there are any formal matters remaining after this response, the examiner is requested to telephone the undersigned to attend to these matters. If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-2112.

Respectfully submitted,

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